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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/842,655	04/27/2001	Haruhiko Kinoshita	048369/0122	7697
22428	7590	08/10/2005	EXAMINER	
FOLEY AND LARDNER SUITE 500 3000 K STREET NW WASHINGTON, DC 20007			THAI, CANG G	
			ART UNIT	PAPER NUMBER
			3629	

DATE MAILED: 08/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/842,655	KINOSHITA, HARUHIKO	
	Examiner	Art Unit	
	Cang G. Thai	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 April 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

1. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. JAPAN 2000-129065, filed on 04/28/2000.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.
3. Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, it is not clear what is the scope of the claimed invention and how the steps are implemented to achieve the scope of the claimed invention? It is not clear on the application service provider (ASP) and how it is connected to the merger and acquisition brokering business? How is the information being obtained and generated with the candidate enterprise?

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

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only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-9 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S.

Patent No. 6,581,039 (MARPE ET AL).

As for claim 1, MARPE discloses a merger and acquisition proposal generation system, wherein a merger and acquisition brokering business entity, one or a plurality of candidate enterprises having a prescribed contractual relationship with said merger and acquisition brokering business entity and desiring generation merger and acquisition proposal {See Fig. 7, Element 700 and Columns 17, Lines 46-50, wherein this reads over "various categories of project management tools 703, a planning guide 705, and industry solution packs 707 relating to a merger and acquisition may be retrieved from a single interface 700"}, and an application service provider are mutually connected via an appropriate communication network {See Fig. 1, Element 135 and Column 9, Lines 27-28, wherein this reads over "engine on a centralized server which may be accessed over a network, i.e. the Internet, via a web site"}, and wherein said system configured that business information indicating general business activities {See Fig. 2, Element 200 and Column 13, Lines 42-45, wherein this reads over "the Navigation Chevron 200 may be located any where on the display, preferably away from the data provided by the knowledge database, such as at the top or to the side of the display"}, including at least financial, accounting, and tax information for each said candidate enterprise is stored at said ASP separately for each said candidate enterprise {Column 10, Lines 38-39, wherein this reads over "the Discussion Database is used to discuss concepts and serve as an audit trail of topics"}, and said merger and acquisition brokering business

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entity having a function whereby said merger and acquisition brokering business entity obtains required information with regard to said candidate enterprise said contractual relationship desiring said generation of a merger and acquisition proposal from said ASP and generates said merger and acquisition proposal for each said candidate enterprise {Column 10, Lines 38-41, wherein this reads over "The Navigation Chevron of the present invention is a form of hypertext that facilitates the navigation of data during the use of the M&A Engine. Hypertext systems are a class of complex information management system"}.

As for claim 2, MARPE discloses a merger and acquisition proposal generation system according to claim 1, wherein an operation of each candidate enterprise for storing business information indicating general business activities thereof at said ASP and an operation of said merger and acquisition brokering business entity generating said merger and acquisition proposal with respect to said candidate enterprises are performed as processing by a computer {Column 15, Lines 38-40, wherein this reads over "a Discussion Database 500 includes a broad topic field 502 having Discussion Groups 503 and 504 relating to specific subject area of the broad topic 502"}.

As for claim 3, MARPE discloses a merger and acquisition proposal generation system according to claim 1, wherein said communication network is the Internet {Column 9, Lines 26-28, wherein this reads over "storing the M&A Engine on a centralized server which may be accessed over a network, i.e. the Internet, via a web site"}.

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As for claim 4, MARPE discloses a merger and acquisition proposal generation system according to claim 1, wherein said ASP is under the control of said merger and acquisition brokering business entity {Column 10, Lines 14-16, wherein this reads over "the M&A Engine also supports the evolution of process-driven methods for the transition by utilizing the Intranet as its delivery vehicle"}.

As for claim 5, MARPE discloses a method for generating merger and acquisition proposal, wherein merger and acquisition brokering business entity which business to make and provide a merger and acquisition proposal candidate enterprises, one a plurality of candidate enterprises having a prescribed contractual relationship with said merger and acquisition brokering business entity and desiring generation of merger and acquisition proposal, an application service provider are mutually connected via an appropriate communication network, said method comprising:

a step of each said candidate enterprise minimally transferring to said application service provider at an appropriate interval, business information indicating general business activities, including financial, accounting, and tax information said candidate enterprise via terminal thereof, so that a condition in which the latest business information indicating general business activities said candidate enterprise, is at all time updated and stored within said application service provider for each said candidate enterprise, is maintained {See Fig. 8, Element 812 and Column 18, Lines 13-15, wherein this reads over "the summary of the status reports, work plans, and accomplished milestones may be outputted on a single interface or on multiple interfaces in operation 812"};

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a step of said candidate enterprises viewing or downloading business information thereof from said application service provider terminal said candidate enterprise at any time {Columns 14-15, Lines 66-67 and Lines 1-2, wherein this reads over "many BBS's also allows users to chat online with other users, send e-mail, download and upload files that include freeware and shareware software, and access the Internet"};

a step said merger and acquisition brokering business entity accessing said application service provider and viewing downloading via a terminal of said merger and acquisition brokering business entity all or part of said information stored at said application service provider regarding a candidate enterprise desiring said generation of a merger and acquisition proposal {Column 16, Lines 6-10, wherein this reads over "the system then adds the documents to the list of available documents contained in the Discussion Group 504 and makes the corresponding document available to other users of the Discussion Database 500"};

a step of said merger acquisition brokering business entity considering said information viewed downloaded regarding said candidate enterprise and generating proposal for a merger acquisition between plurality of specific said candidate enterprises {Columns 14-15, Lines 66-67 and Lines 1-2, wherein this reads over "many BB'S also allow users to chat online with other users, send e-mail, download and upload that include freeware and shareware software, and access the Internet"}; and

a step of said merger and acquisition brokering business entity notifying said candidate enterprises of said generated merger and acquisition proposal {Column 18, Lines 13-15, wherein this reads over "a summary of the status reports, work plans, and

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accomplished milestones may be outputted on a single interface or on multiple interfaces in operation 812"}.

As for claim 6, MARPE discloses a merger and acquisition proposal generation system according to claim 1, wherein said ASP is under the control of said merger and acquisition brokering business entity {Column 10, Lines 14-16, wherein this reads over "the M&A Engine also supports the evolution of process-driven methods for the transition by utilizing the Intranet as its delivery vehicle"}.

As for claim 7, MARPE discloses a merger and acquisition proposal generation system according to claim 1, wherein said communication network is the Internet {Columns 14-15, Lines 66-67 and Lines 1-2, wherein this reads over "many BBS's also allows users to chat online with other users, send e-mail, download and upload files that include freeware and shareware software, and access the Internet"}.

As for claim 8, MARPE discloses a merger and acquisition proposal generation method wherein a merger and acquisition brokering business entity in a business providing a merger acquisition proposal to a candidate enterprise, one or a plurality candidate enterprises having a prescribed contractual relationship with said merger and acquisition brokering business entity and desiring generation of said merger and acquisition proposal, and an application service provider are mutually electrically connected via a communication network, said method comprising:

a first step of said candidate enterprises desiring said generation of a merger and acquisition proposal minimally transmitting to said application service provider, via a terminal thereof, business information indicating general business activities, such as

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financial, accounting, and tax information, and storing, updating, deleting, or reviewing said information said application service provider {Column 10, Lines 38-39, wherein this reads over "the Discussion Database is used to discuss concepts and serve as an audit trail of topics"};

a second step said application service provider separately storing into individual files for each said candidate enterprise said business information sent by each said candidate enterprises and, when there is a request from either said candidate enterprises or from said merger and acquisition brokering business entity, providing said business information regarding a prescribed said candidate enterprise to a prescribed said candidate enterprise or merger and acquisition brokering business entity {Column 16, Lines 6-10, wherein this reads over "the system then adds the documents to the list of available documents contained in the Discussion Group 504 and makes the corresponding document available to other users of the Discussion Database 500"};

a third step of said merger and acquisition brokering business entity accessing said application service provider, considering said business information regarding a prescribed said candidate enterprise, which it views or downloads from said application service provider, and generating said merger and acquisition proposal with regard to said prescribed candidate enterprises of said candidate enterprises {Columns 17, Lines 46-50, wherein this reads over "various categories of project management tools 703, a planning guide 705, and industry solution packs 707 relating to a merger and acquisition may be retrieved from a single interface 700"}; and

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a fourth step of said merger and acquisition brokering business entity notifying said candidate enterprises of said merger and acquisition proposal with regard to said candidate enterprises {Column 18, Lines 13-15, wherein this reads over "a summary of the status reports, work plans, and accomplished milestones may be outputted on a single interface or on multiple interfaces in operation 812"},

wherein each of said steps is controlled by a computer {Columns 14-15, Lines 66-67 and Lines 1-2, wherein this reads over "many BBS's also allows users to chat online with other users, send e-mail, download and upload files that include freeware and shareware software, and access the Internet"}.

As for claim 9, MARPE discloses a recording medium onto which has been recorded a program for execution by a computer of a merger and acquisition proposal generation method, wherein a merger and acquisition brokering business entity in a business of performing ranking of enterprises, one or a plurality of candidate enterprises having a prescribed contractual relationship with said merger and acquisition brokering business entity and desiring generation of a merger and acquisition proposal, and an application service provider are mutually electrically connected via communication network, said method comprising:

a first step of each said candidate enterprise minimally transferring business information indicating general business activities such as financial, accounting, and tax information, via a terminal of said candidate enterprises, to said application service provider at an appropriate interval, and maintaining said business information so as indicate the latest business activities of each of said candidate enterprises at all times

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updating said information at said application service provider {Column 10, Lines 38-39, wherein this reads over "the Discussion Database is used to discuss concepts and serve as an audit trail of topics"};

a second step of said candidate enterprises viewing or downloading via their own terminals their own business information from said application service provider at any time {Columns 17, Lines 46-50, wherein this reads over "various categories of project management tools 703, a planning guide 705, and industry solution packs 707 relating to a merger and acquisition may be retrieved from a single interface 700"};

a third step of said merger and acquisition brokering business entity accessing said application service provider and viewing downloading, via a terminal of said merger and acquisition brokering business entity, all or part said information with regard to said candidate enterprise desiring said generation of a merger and acquisition proposal that is stored at said application service provider {Column 16, Lines 6-10, wherein this reads over "the system then adds the documents to the list of available documents contained in the Discussion Group 504 and makes the corresponding document available to other users of the Discussion Database 500"};

a fourth step of said merger and acquisition brokering business entity using said viewed or downloaded information regarding said candidate enterprise, and analyzing and evaluating said information so as to generate a merger and acquisition proposal with respect to said candidate enterprise {Columns 14-15, Lines 66-67 and Lines 1-2, wherein this reads over "many BBS's also allows users to chat online with other users,

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send e-mail, download and upload files that include freeware and shareware software, and access the Internet"}, and

a fifth step said merger and acquisition brokering business entity disclosing results of a ranking of said enterprise {Column 18, Lines 13-15, wherein this reads over "a summary of the status reports, work plans, and accomplished milestones may be outputted on a single interface or on multiple interfaces in operation 812"}.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

I. U.S. Patent:

- 1) U.S. Patent No. 6,477,434 (WEWALAARACHCHI ET AL) is cited to teach a method and apparatus for the creation of personalized supervisory and control data acquisition systems for the management and integration of real-time enterprise-wide application and systems,
- 2) U.S. Patent No. 6,067,477 (WEWALAARACHCHI ET AL) is cited to teach a method and apparatus for the creation of personalized supervisory and control data acquisition systems for the management and integration of real-time enterprise-wide application and systems, and
- 3) U.S. Patent No. 6,915,269 (SHAPIRO ET AL) is cited to teach a system and method for facilitating bilateral and multilateral decision-making.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cang (James) G. Thai whose telephone number is (571) 272-6499. The examiner can normally be reached on 6:30 AM - 3:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CGT
8/4/2005



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